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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/765,304
Filing Date: January 27, 2004
Appellant(s): FORD ET AL.

Daniel E. Ford, et al.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/18/2008 appealing from the Office action

mailed 6/10/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2004/0003135	Moore	01-2004
6,704,864	Philyaw	03-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

A.   Whether or not dependent claims 30-32 are unpatentable under 35 U.S.C. § 101 because the invention is allegedly directed to non-statutory subject matter.

Regarding dependent claims 30-32, the subject matter thereof is not directed to non-statutory subject matter.

Appellant notes that the bodies of dependent claims 30-32 have not been rejected under 35 U.S.C. § 101. That is, the Examiner appears to have rejected dependent claims 30-32 based upon the preamble recitations.

Appellant further notes that claims 30-32 depend directly or indirectly from independent claim 29. The preamble of independent claim 29, as previously presented, is not currently rejected under 35 U.S.C. § 101. Appellant's independent claim 29 includes the statutory subject matter of "a computer readable storage medium having program instructions that are executed by a computing device to cause a device to perform a method." Support for the recited language of independent claim 29 can be

found at page 9, lines 10-15, of Appellant's

specification where the specification states, "many of these devices include

processor(s) and memory hardware. Computer executable instructions, (e.g., software

and/or firmware) reside in memory, such as on a management station or other device,

to manage a device feature, and/or manage a network".

Appellant respectfully submits that dependent claims 30-32 inherit all the

elements and limitations of the independent claim from which they depend. Hence,

Appellant respectfully submits that the preambles of dependent claims 30-32 arc similar

enough to the preamble of independent claim 29 to provide a reader with a clear

understanding that they refer to independent claim 29.

Nonetheless, Appellant is willing to amend the preambles to dependent claims

30-32, if determined to be necessary by review of the present appeal brief, to include

sufficient preamble language of independent claim 29 to overcome the 35 U.S.C. § 101

rejection.

B.   Whether or not claims 1-7, 9-11, 13, 14,/6-24, 28-30, and 33-37 are

unpatentable under 35 USC § 102(e) as allegedly being anticipated by Moore (U.S.

Pub. No. 2004/0003135) (Technique for Driver Installation).

Regarding claims 1-7, 9-11, 13, 14, 16-24, 28-30, and 33-37, the cited reference

does not teach each and every clement.

Appellant does not admit that the Moore '135 reference is indeed prior art and reserves

the right to swear behind at a future date. Nonetheless, Appellant respectfully submits

that the elements and limitations of the claims of the present application, as recited

herein, are patentably distinguishable from the teachings of the cited reference for at least the following reasons.

Appellant's independent claims 1, 16, and 29 each recite calling "a routine in a particular driver from the selected set of drivers which executes to determine whether the particular driver is most appropriate to perform the particular device function for a particular device."

Independent claim 9 recites, "the particular driver having program instructions stored in memory and executable on the processor to: perform analysis to determine whether the particular driver is appropriate to perform a particular device function."

Additionally, independent claim 24 recites, "selecting a particular driver from the selected set of drivers; and performing analysis within the particular driver to determine whether the particular driver is appropriate to perform a particular device function."

Independent claim 33 recites, "means for automatically selecting, from among a number of drivers, a particular driver having features which most closely correlates to a set of device features of a device, where a routine is called in the particular driver which executes to determine a correlation of the particular driver to the set of device features of a device."

In contrast, the Moore reference appears to describe gathering "operating system information about the operating system and device information about the device and generates one or more device identifiers by concatenating the operating system information with the device information." (Page 1, paragraph 0010, lines 3- 7). The Moore reference goes on to state, "The generated identifiers are then used to select

and install the appropriate device driver for the device." (Page 1, paragraph 0010, lines 7-9).

The Moore reference appears to teach, on page 2, paragraph 0026, lines 5-11:

NEWDEV [New Device Dynamic-Linked Library] 210 is a software library that comprises software routines that are used to initiate the installation of a driver associated with a new device. SETUP [Setup Application Programming Interface] 220 is an application-programming interface (API) that comprises sol, are routines that perform various device driver installation tasks such as searching the [driver information] INF files and building a potential list of device drivers associated with the new device.

The Moore reference appears to go on to teach, on page 3, paragraph 0034, lines 1-13:

At Step 445, NEWDEV 210 calls SETUP 220 to build a list of possible drivers that can be used with device 165. SETUP 220 prompts the user to specify the location of the INF files associated with device 165's driver, as indicated at Step 450. The location specified could be, for example, a directory on a CD-ROM contained in removable disk 110 or a disk drive on the data network that is accessible through NIC 117. At Step 455, SETUP 220 searches the user-specified location to find INF files that contain information that matches the device IDs. If an INF file is found to match, device driver information contained in the matching INF file that specifies a particular driver is added to the list of possible drivers.

In addition, the Moore reference appears to further teach, "SETUP 220 assigns a rank to each possible driver in the list and selects the best driver for device 165." (Page

3, paragraph 0035, lines 1-3).

The Moore reference appears to use a NEWDEV Dynamic-Linked Library (DLL) 210 to call up software routines from the SETUP Application Programming Interface 220 within the computer system to select the best driver for a device using INF files associated with the device. The Moore reference also appears to require that the SETUP 220 prompts the user to specify the location of the INF files associated with device 165's driver.

Appellant respectfully submits that neither the NEWDEV Dynamic-Linked Library nor the SETUP Application Programming Interface is a driver dedicated to or capable of controlling a device as described in the present application. That is, Appellant respectfully submits that the Moore reference does not teach calling a routine in a particular device driver from the selected set of drivers that automatically executes to determine whether the particular device driver is most appropriate to perform the particular device function for a particular device.

In the Response to Arguments section of the June 10, 2008, Final Office Action, the Examiner stated that, based upon a clause of one sentence appearing in the www.freebyte.com/driver/#introducdon website without further explanation, "A driver is a program or dll that controls a device" (emphasis added by the Examiner in the FOA). Appellant respectfully submits that whether or not a DLL can in some situations potentially function as a driver, in the Moore reference the NEWDEV Dynamic-Linked Library (DLL) does not function as, nor have the potential to function as, a driver that controls a device. That is, "NEWDEV 210 calls SETUP 220 to build a list of possible

drivers that can be used with device 165." (Moore page 3, paragraph 0034, lines 1-3).

Moreover, Appellant respectfully submits that the SETUP Application

Programming Interface, as described in the Moore reference, does not function as, nor

have the potential to function as, a driver that controls a device. That is, "SETUP 220

searches the user-specified location to find INF files that contain information that

matches the device IDs." (Page 3, paragraph 0034, lines 8-10).

Hence, Appellant respectfully submits that the Moore reference does not

teach, as recited in independent claims 1, 16, and 29:

<u>calling a routine in a particular driver</u> from the selected set of drivers <u>which</u>

<u>executes to determine whether the particular driver is most appropriate to perform the</u>

<u>particular device function</u> for a particular device.

Nor does the Moore reference teach, as recited in independent claim 9:

<u>the particular driver having program</u> instructions stored in memory and

executable on the processor to: <u>perform analysis to determine whether the particular</u>

<u>driver is appropriate to perform a particular device function.</u>

Nor does the Moore reference teach, as recited in independent claim 24:

<u>performing analysis within the particular driver</u> to determine whether the

particular driver is appropriate to perform a particular device function.

In addition, the Moore reference does not teach, as recited in independent claim 33:

<u>means for automatically selecting, from among a number of drivers</u>, a particular

driver having features which most closely correlates to a set of device features of a

device, where <u>a routine is called in the particular driver which executes to determine a</u>

correlation of the particular driver to the set of device features of a device.

As such, Appellant respectfully submits that the Moore reference does not leach each and every element and limitation of independent claims 1, 9, 16, 24, 29, and 33. Accordingly, Appellant respectfully requests reconsideration and withdrawal of the § 102(e) rejection of independent claims 1, 9, 16, 24, 29, and 33, as well as those claims that depend therefrom.

C.   Whether or not dependent claims 15, 25, and 27 are unpatentable under 35 USC § 103(a) over Moore (U.S. Pub. No. 2004/0003135).

Regarding dependent claims 15, 25, and 27, the cited reference does not teach, suggest, or render obvious each and every element.

As presented above, Appellant does not admit that the Moore '135 reference is indeed prior art and reserves the right to swear behind at a future date. Nonetheless, Appellant respectfully submits that the elements and limitations of the claims of the present application, as recited herein, are patentably distinguishable from the teachings of the cited reference for at least the foll0wing reasons.

Claim 15 depends from independent claim 9 and claims 25 and 27 depend from independent claim 24 of the present application. For the reasons presented above, Appellant respectfully submits that the Moore reference does not teach, suggest, or render obvious each and every element of independent claims 9 and 24.

For example, the Moore reference does not appear to teach, suggest, or render obvious, "the particular driver having program instructions stored in memory and executable on the processor to: perform analysis to determine whether the particular

driver is appropriate to perform a particular device function", as recited in

independent claim 9. Nor does the Moore reference teach, suggest, or render obvious,

"performing analysis within the particular driver to determine whether the particular

driver is appropriate to perform a particular device function", as recited in independent

claim 24.

As such, the deficiencies of the Moore reference with regard to independent

claims 9 and 24 are not cured by rejection of dependent claims 15, 25, and 27.

Accordingly, Appellant respectfully requests reconsideration and withdrawal of the §

103(a) rejection of dependent claims 15, 25, and 27.

D.   Whether or not claims 12, 26, 31, and 32 are unpatentable Under 35 USC

§ 103(a) over Moore (U.S. Pub. No. 2004/0003135) as applied to claims 9, 24 and 29

above, and further in view of Philyaw (U.S. Patent No. 6,704,864) (Automatic

Configuration of Equipment Software).

Regarding dependent claims 12, 26, 31, and 32, the cited reference does not

teach, suggest, or render obvious each and every element.

As presented above, Appellant does not admit that the Moore '135 reference is

indeed prior art and reserves the right to swear behind at a future date. Nonetheless,

Appellant respectfully submits that the elements and limitations of the claims of the

present application, as recited herein, are patentably distinguishable from the teachings

of the cited reference for at least the following reasons.

Claim 12 depends from independent claim 9, claim 26 depends from

independent claim 24, and claims 31 and 32 depend from independent claim 29 of the

present application. For the reasons presented above, Appellant respectfully submits

that the Moore reference does not teach, suggest, or render obvious each and every

element of independent claims 9, 24, and 29. In addition, Appellant respectfully submits

that the Philyaw '864 reference does not cure the deficiencies of the Moore reference

with regard to independent claims 9, 24, and 29.

That is, the Philyaw reference does not teach, suggest, or render obvious, "the

particular driver having program instructions stored in memory and executable on the

processor to: perform analysis to determine whether the particular driver is appropriate

to perform a particular device function", as recited in independent claim 9. Nor does the

Philyaw reference teach, suggest, or render obvious, "performing analysis within the

particular driver to determine whether the particular driver is appropriate to perform a

particular device function," as recited in independent claim 24. In addition, the Philyaw

reference does not teach, suggest, or render obvious, "calling a routine in a particular

driver from the selected set of drivers which executes to determine whether the

particular driver is most appropriate to perform the particular device function for a

particular device", as recited in independent claim 29.

As such, Appellant respectfully submits that the presently claimed invention is not

taught by, nor made obvious in view of, the combination of the Moore and Philyaw

references. Accordingly, Appellant respectfully requests reconsideration and withdrawal

of the § 103(a) rejection of dependent claims 12, 26, 31, and 32.

(10) Response to Argument

A.   Appellants' arguments and Examiner's responses regarding claims 30-32 are as follows:

Regarding dependent claims 30-32, the subject matter thereof is not directed to non-statutory subject matter.

Appellants' argument: Dependent claims 30-32 are not directed to non-statutory subject matter.

Examiner's response: The specification provides no explicit and deliberate definition of the computer readable medium. The computer medium indicates storage medium or transmission medium. The computer readable medium indicating transmission medium is not in one of the statutory categories and, as such, fails to establish a statutory category of invention. Therefore, the Examiner suggests to replace the computer readable medium with computer storage medium in the claims as well as in the specification.

B.   Appellants' arguments and Examiner's responses regarding independent claims 1, 9, 16, 24, 29 and 33 are as follows:

Appellants' argument: The NEWDEV Dynamic-Linked Library nor the SETUP Application Programming Interface is a driver dedicated to or capable of controlling a device as described in the present application. That is, Appellant respectfully submits that the Moore reference does not teach calling a routine in a particular device driver from the selected set of drivers that automatically executes to

determine whether the particular device driver is most appropriate to perform the

particular device function for a particular device.

Examiner's response: Moore teaches that NEWDEV calls SETUP to build a

list of possible drivers that can be used with device (see, e.g., page 3, paragraph [0034],

lines 1-2) and SETUP assigns a rank to each possible driver in the list and selects the

best driver for device (see, e.g., page 3, paragraph [0035], lines 1-3). The technique

used to rank the drivers inherently includes a routine for each possible driver in the list

in order to decide the appropriate rank (see, e.g., page 3, paragraph [0035], lines 8-12).

Therefore, Moore teaches of calling a routine in a particular driver (each possible

driver) from the selected set of drivers (possible drivers) which executes to determine

whether the particular driver is most appropriate (assigning a rank) to perform the

particular device function for a particular device (testing each possible driver in the list of

possible drivers in order to assign a rank which indicates how well the driver matches

the device, see, e.g., page 3, paragraph [0035]).

C.   Appellants' arguments and Examiner's responses regarding dependent

claims 15, 25, and 27 are as follows:

Appellants' argument: Claim 15 depends from independent claim 9 and

claims 25 and 27 depend from independent claim 24 of the present application. For the

reasons presented above, Appellant respectfully submits that the Moore reference does

not teach, suggest, or render obvious each and every element of independent claims 9

and 24.

Examiner's response: Moore teaches that NEWDEV calls SETUP to build a list of possible drivers that can be used with device (see, e.g., page 3, paragraph [0034], lines 1-2) and SETUP assigns a rank to each possible driver in the list and selects the best driver for device (see, e.g., page 3, paragraph [0035], lines 1-3). The technique used to rank the drivers inherently includes a routine for each possible driver in the list in order to decide the appropriate rank (see, e.g., page 3, paragraph [0035], lines 8-12).

Therefore, Moore teaches of calling a routine in a particular driver (each possible driver) from the selected set of drivers (possible drivers) which executes to determine whether the particular driver is most appropriate (assigning a rank) to perform the particular device function for a particular device (testing each possible driver in the list of possible drivers in order to assign a rank which indicates how well the driver matches the device, see, e.g., page 3, paragraph [0035]).

D.   Appellants' arguments and Examiner's responses regarding dependent claims 12, 26, 31, and 32 are as follows:

Appellants' argument: Claim 12 depends from independent claim 9, claim 26 depends from independent claim 24, and claims 31 and 32 depend from independent claim 29 of the present application. For the reasons presented above, Appellant respectfully submits that the Moore reference does not teach, suggest, or render obvious each and every element of independent claims 9, 24, and 29. In addition,

Appellant respectfully submits that the Philyaw '864 reference does not cure the deficiencies of the Moore reference with regard to independent claims 9, 24, and 29.

Examiner's response: Moore teaches that NEWDEV calls SETUP to build a list of possible drivers that can be used with device (see, e.g., page 3, paragraph [0034], lines 1-2) and SETUP assigns a rank to each possible driver in the list and selects the best driver for device (see, e.g., page 3, paragraph [0035], lines 1-3). The technique used to rank the drivers inherently includes a routine for each possible driver in the list in order to decide the appropriate rank (see, e.g., page 3, paragraph [0035], lines 8-12).

Therefore, Moore teaches of calling a routine in a particular driver (each possible driver) from the selected set of drivers (possible drivers) which executes to determine whether the particular driver is most appropriate (assigning a rank) to perform the particular device function for a particular device (testing each possible driver in the list of possible drivers in order to assign a rank which indicates how well the driver matches the device, see, e.g., page 3, paragraph [0035]).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/J. S. P./

Examiner, Art Unit 2454

September 31, 2008

Conferees:

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